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Client/Matter: 007874-0271791

REMARKS

Claims 1-35 are pending. By this Amendment, claims 1 and 29 are amended. Reconsideration in view of the above amendments and following remarks is respectfully requested.

This Amendment is proper under 37 C.F.R. § 1.116 as the amendments: (a) place the application in condition for allowance for the reasons discussed herein; (b) do not raise any new issues that would require further consideration and/or search; (c) do not present any additional claims without canceling a corresponding number of claims; and (d) place the application in better condition for appeal, should an appeal be necessary. The amendments are necessary and were not earlier presented as they are in response to new grounds of rejection entered in the previous Office Action. Entry of this Amendment is respectfully requested.

Claims 1-11, 15, 17-18 and 20-35 were rejected under 35 U.S.C. §103(a) over Mobile Commerce (U-V) in view of PR Newswire (X). The rejection is respectfully traversed.

MPEP § 2143 states: "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations."

It is respectfully submitted that the combination of Mobile Commerce (U-V) and PR Newswire (X) fails to establish a *prima facie* case of obviousness because, at least, the combination fails to include all the claim limitations.

With respect to Applicant's arguments regarding the applicability of PR Newswire (X) and Gifford (U.S. Patent 5,724,424), the Examiner, on page 3, lines 4-6, of the Office Action states: "PR Newswire discloses US 5,724,424 (Gifford) and ties it to the Assignee. It is proper to rely upon specific disclosures cited in Gifford. Adding Gifford in the rejection is redundant. Applicants respectfully disagree and submit that the Examiner is entirely incorrect.

PR Newswire (X) discloses that U.S. Patent 5,724,424 issued to Gifford on March 3, 1998 and is assigned to Open Market, Inc. PR Newswire (X) further alleges that U.S. Patent 5,724,424 is one of the earliest and broadest Internet payment patents granted.

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PR Newswire (X) discloses absolutely nothing about the disclosure of U.S. Patent 5,724,424 to Gifford, other than the general allegations of its breadth and early filing date discussed above. PR Newswire (X) does not incorporate U.S. Patent 5,724,424, nor does it provide any suggestion or motivation to combine U.S. Patent 5,724,424 to Gifford with any other prior art, including Mobile Commerce (U-V).

As discussed above, the establishment of a *prima facie* case of obviousness requires that the combination of references include all the claim limitations. It is respectfully submitted that the Examiner's refusal to consider, or acknowledge, or list U.S. Patent 5,724,424 as a reference in the rejection under 35 U.S.C. § 103(a) is merely an attempt to maintain, improperly, the finality of the Office Action. Regardless of the semantics employed by the Examiner, it is respectfully submitted that the Examiner's citation of column and line numbers and figures of U.S. Patent 5,724,424 clearly establish that the actual combination is Mobile Commerce (U-V) in view of U.S. Patent 5,724,424 to Gifford. As Applicant is more interested in advancing the prosecution of the application than debating the propriety of the finality of the Office Action, the following remarks will address the failure of any combination of Mobile Commerce (U-V), PR Newswire (X), and/or U.S. Patent 5,724,424 to Gifford to present a *prima facie* case of obviousness against any of the claims.

Claims 1 recites an electronic settlement system to settle a transaction using a telecommunication network including, *inter alia*, a billing terminal for performing billing of the transaction, a paying terminal for performing paying of the transaction, the paying terminal allowing a user to input information, a settlement apparatus for registering the paying terminal and performing the settlement of the transaction taking place between the billing terminal and the paying terminal via the telecommunication network, the settlement apparatus providing a transaction identifying number relating to the transaction with the billing terminal and presenting the transaction identifying number by the telecommunication network. The settlement apparatus synchronizes a communication to the billing terminal where the communication to the paying terminal when receiving the transaction identifying number as a user input information from the register paying terminal.

Neither Mobile Commerce nor PR Newswire nor Gifford, either alone or in combination, disclose at least a settlement apparatus for registering a paying terminal and performing the settlement of a transaction taking place between a billing terminal and the paying terminal via a telecommunication network, the settlement apparatus providing a transaction identifying number related to the transaction with the billing terminal and

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presenting the transaction identifying number by the telecommunication network, wherein the settlement apparatus synchronizes a communication to the billing terminal with a communication to the paying terminal when receiving a transaction identifying number as a user input information from the registered paying terminal. Accordingly, the combination of Mobile Commerce and PR Newswire does not disclose or suggest all the limitations of claim 1 and fails to present a *prima facie* case of obviousness against claim 1.

Mobile Commerce (U) discloses that one of Cellner's services allows customers who have a Barclay credit card to obtain statement and other information on the phone's screen. As acknowledged further in the article, this is just pushing information to the user. There is no disclosure or suggestion that this service permits the user's phone to act as a paying terminal allowing a user to input information, as recited in claim 1.

Mobile Commerce (U) further discloses that German software company Brokat provides an X-SMS banking service that, as of April, 1998, permitted customers to authorize secure payments and transfers to other accounts, pay bills or check balances by keying in a PIN on their cell phone as confirmation, or by use of electronic signatures stored in SIM2 cards. However, there is no disclosure or suggestion of a settlement apparatus that synchronizes a communication to a billing terminal with a communication to a paying terminal when receiving a transaction identifying number as a user input, the settlement apparatus providing the transaction identifying number relating to the transaction with the billing terminal. A PIN is not a transaction identifying number relating to a transaction. An electronic signature is also not a transaction identifying number relating to a transaction.

Mobile Commerce (V) is nothing more than a discussion of the possible applications of smart cards and does not cure either deficiency of Mobile Commerce (U) discussed above with respect to claim 1.

As discussed above, PR Newswire (X) discloses nothing relevant to the claimed invention.

The portions of Gifford cited by the Examiner, in particular column 1, line 5 through column 3, line 59; column 7, line 39 through column 12, line 6; column 2, lines 54-58; column 5, lines 29-44; column 11, lines 8-21; and column 10, lines 54-62, fail to cure the deficiencies of Mobile Commerce (U-V) and PR Newswire (X) discussed above with respect to claim 1 because Gifford also fails to disclose or suggest a settlement apparatus that synchronizes a communication to a billing terminal with a communication to a paying terminal when receiving a transaction identifying number as a user input, the settlement

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apparatus providing the transaction identifying number relating to the transaction with the billing terminal. A PIN is not a transaction identifying number relating to a transaction. An electronic signature is also not a transaction identifying number relating to a transaction.

As the combination of Mobile Commerce, PR Newswire (X) and Gifford fails to include all the limitations of claim 1, the combination fails to present a *prima facie* case of obviousness.

Claim 3 recites a settlement apparatus including a processing unit that, *inter alia*, synchronizes a communication to a billing terminal with a communication to a paying terminal when the processing unit sets a transaction identifying number to identify the transaction and when the paying terminal transmits to the settlement apparatus a transaction identifying number as a user input information which is the same as the transaction identifying number. The combination of Mobile Commerce (U-V), PR Newswire (X) and Gifford fails to include, at least, this feature and the combination fails to present a *prima facie* case of obviousness against claim 3.

Claims 2 and 4-11, 15, 17, 18 recite additional features of the invention and are allowable for the same reasons discussed above with respect to claims 1 and 3, respectively, and for the additional features recited therein.

Claim 20 recites a billing terminal, communicating with a settlement apparatus which performs a settlement of transaction, for performing billing of the transaction with a paying terminal which performs paying of the transaction. The paying terminal allows a user to input information. The billing terminal includes a communication unit which connects to the settlement apparatus via a telecommunication network. The communication unit transmits an identifying number to identify the billing terminal to the settlement apparatus and the communication unit receives a synchronization confirmation signal indicating an establishment of a synchronization with the paying terminal from the settlement apparatus when the settlement apparatus receives the identifying number as a user input information. A processing unit performs billing processing of the transaction.

The combination of Mobile Commerce (U-V), PR Newswire (X) and Gifford fails to include, at least, a billing terminal communicating with a settlement apparatus and including a communication unit which connects to the settlement apparatus via a telecommunication network, a communication unit transmitting an identifying number to identify the billing terminal to settlement apparatus and receiving a synchronization confirmation signal indicating an establishment of synchronization with the paying terminal from the settlement

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apparatus when the settlement apparatus receives the identifying number as a user input information. Accordingly, the combination fails to present a *prima facie* case of obviousness against claim 20.

Claims 21-26 recite additional features of the invention and are allowable for the same reasons discussed above with respect to claim 20 and for the additional features recited therein.

Claim 27 recites a recording medium that stores a program for a computer, communicating to a billing terminal performing billing of a transaction with a paying terminal performing paying of the transaction. The paying terminal allows a user to input information. The program includes a processing module that sets a transaction identifying number which identifies the transaction and synchronizes a communication to the billing terminal with a communication to the paying terminal when the paying terminal transmits a transaction identifying number as a user input information which is the same as the transaction identifying number to the settlement apparatus.

The combination of Mobile Commerce (U-V), PR Newswire (X) and Gifford fails to include, at least, setting a transaction identifying number which identifies a transaction and synchronizes a communication to a billing terminal with a communication to a paying terminal when the paying terminal transmits a transaction identifying number as a user input information which is the same as the transaction identifying number to the settlement apparatus. Accordingly, the combination fails to present a *prima facie* case of obviousness.

Reconsideration and withdrawal of the rejection of claim 27 are respectfully requested.

Claim 28 recites a method of settlement using a settlement apparatus which performs the settlement of a transaction while communicating to a billing terminal. The paying terminal allows a user to input information. The method includes, *inter alia*, synchronizing a communication to the billing terminal where the communication to the paying terminal when the paying terminal confirms the information about the billing terminal and transmits a transaction identifying number as a user input information to the settlement apparatus.

There is no disclosure or suggestion by either Mobile Commerce (U-V), PR Newswire (X), or Gifford of synchronizing a communication to a billing terminal with a communication to a paying terminal when the paying terminal confirms the information about the billing terminal and transmits the transaction identifying number as a user input information to a settlement apparatus, as recited in claim 28. Accordingly, the combination

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fails to include all the limitations of claim 28 and fails to present a *prima facie* case of obviousness.

Claim 29 recites a settlement method using a settlement apparatus performing a settlement of a transaction for communicating to a billing terminal performing billing of the transaction with a paying terminal performing paying of the transaction. The paying terminal allows a user to input information. The method includes, *inter alia*, synchronizing a communication to the billing terminal with a communication to the paying terminal, when the paying terminal confirms the information about the billing terminal and transmits the transaction identifying number as a user input information to the settlement apparatus.

There is no disclosure or suggestion by either Mobile Commerce (U-V), PR Newswire (X) or Gifford of synchronizing a communication to a billing terminal with a communication to a paying terminal, when the paying terminal confirms the information about the billing terminal and transmits the transaction identifying number as a user input information to the settlement apparatus. Therefore, the combination fails to include all the limitations in claim 29 and fails to present a *prima facie* case of obviousness.

Claim 30 recites, *inter alia*, that the settlement apparatus synchronizes a communication to the billing terminal with a communication to the paying terminal when receiving a user ID from the registered paying terminal. There is no disclosure or suggestion by any of Mobile Commerce (U-V), PR Newswire (X) or Gifford of synchronizing a communication to a billing terminal with a communication to a paying terminal. Therefore, the combination fails to present a *prima facie* case of obviousness.

Claim 31 recites a settlement apparatus wherein, *inter alia*, a processing unit sets a transaction identifying number to identify the transaction and synchronizes a communication to a billing terminal with a communication to a paying terminal when the paying terminal transmits to the settlement apparatus a user ID as a transaction identifying number which is the same as the transaction identifying number. None of Mobile Commerce (U-V), PR Newswire (X) or Gifford disclose or suggest these features, either alone or combination. The combination therefore fails to present a *prima facie* case of obviousness.

Claim 32 recites a billing terminal, communicating with a settlement apparatus which performs a settlement of transaction, for performing billing of the transaction, with a paying terminal which performs paying of the transaction. The billing terminal includes, *inter alia*, a communication unit which connects to the settlement apparatus via a telecommunication network, the communication unit transmitting a user ID as an identifying number to identify

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the billing terminal to the settlement apparatus, and the communication unit receiving a synchronization confirmation signal indicating an establishment of synchronization with the paying terminal from the settlement apparatus.

There is no disclosure or suggestion by either Mobile Commerce (U-V), PR Newswire (X), or Gifford, either alone or in combination, of a communication unit which connects to the settlement apparatus via a telecommunication network, the communication unit transmitting a user ID as an identifying number to identify the billing terminal to the settlement apparatus, and the communication unit receiving a synchronization confirmation signal indicating an establishment of synchronization with the paying terminal from the settlement apparatus. Accordingly, the combination fails to present a *prima facie* case of obviousness.

Claim 33 recites a recording medium which stores a program for a computer, communicating to a billing terminal performing billing of a transaction with a paying terminal performing paying of the transaction, and performing the settlement of transaction. The program includes a first communication module which operates the computer to communicate to the billing terminal via a commercial telephone line or a private line; a second communication module which operates the computer to communicate to the paying terminal via a radio telephone communication; and a processing module which performs the settlement of transaction, wherein the processing module sets a transaction identifying number which identifies the transaction and the processing module synchronizes a communication to the billing terminal with a communication to the paying terminal when the paying terminal transmits a transaction identifying number which is the same as the transaction identifying number to the settlement apparatus.

There is no disclosure or suggestion by Mobile Commerce (U-V), PR Newswire (X) or Gifford of a recording medium including, at least, the processing module sets a transaction identifying number which identifies the transaction and the processing module synchronizes a communication to the billing terminal with a communication to the paying terminal when the paying terminal transmits a transaction identifying number which is the same as the transaction identifying number to the settlement apparatus, as recited in claim 33. Accordingly, the combination fails to present a *prima facie* case of obviousness.

Claim 34 recites a method of settlement using a settlement apparatus which performs the settlement of transaction while communicating to a billing terminal which performs billing of a transaction with a paying terminal which performs paying of the transaction. The

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method includes establishing communication to the billing terminal based on information identifying the billing terminal, and setting a user ID as a transaction identifying number to identify an order transaction of an item, when the paying terminal transmits the information identifying the billing terminal to the settlement apparatus for ordering the item; transmitting information about the billing terminal with the transaction identifying number to the paying terminal; synchronizing a communication to the billing terminal with a communication to the paying terminal when the paying terminal confirms the information about the billing terminal and transmits the transaction identifying number to the settlement apparatus; transmitting a synchronization confirmation signal which indicates that the synchronization is established with the billing terminal; receiving the order of the item from the paying terminal; transmitting the order of the item received from the paying terminal to the billing terminal; receiving a purchase amount based on the order of the item from the billing terminal; and performing a process of settlement of the transaction between the billing terminal and the paying terminal, both of which are synchronized with each other by the transaction identifying number, based on the purchase amount.

There is no disclosure by either Mobile Commerce (U-V), PR Newswire (X) or Gifford of, at least, 1) synchronizing a communication to the billing terminal with a communication to the paying terminal when the paying terminal confirms the information about the billing terminal and transmits the transaction identifying number to the settlement apparatus; 2) transmitting a synchronization confirmation signal which indicates that the synchronization is established with the billing terminal; or performing a process of settlement of the transaction between the billing terminal and the paying terminal, both of which are synchronized with each other by the transaction identifying number, based on the purchase amount. Therefore, the combination fails to include all the limitations and fails to present a *prima facie case* of obviousness.

Claim 35 recites a settlement method using a settlement apparatus performing a settlement of a transaction for communicating to a billing terminal performing billing of the transaction with a paying terminal performing paying of the transaction. The method includes establishing communication to the billing terminal and setting a user ID as a transaction identifying number to identify the transaction of order of an item, when the user of the paying terminal orders the item to an order receiving center accepting the order of the item and the billing terminal receives the order of the item ordered by the user from the order receiving center and transmits information identifying the billing terminal to the settlement apparatus;

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transmitting information about the billing terminal with the transaction identifying number to the paying terminal; synchronizing a communication to the billing terminal with a communication to the paying terminal, when the paying terminal confirms the information about the billing terminal and transmits the transaction identifying number to the settlement apparatus; transmitting a synchronization confirmation signal indicating the establishment of synchronization with the billing terminal; receiving a purchase amount based on the order of the item from the billing terminal; and processing settlement of the transaction between the billing terminal and the paying terminal, both of which are synchronized with each other by the transaction identifying number, based on the purchase amount.

Neither Mobile Commerce (U-V), PR Newswire (X), nor Gifford discloses or suggests, at least, 1) synchronizing a communication to the billing terminal with a communication to the paying terminal, when the paying terminal confirms the information about the billing terminal and transmits the transaction identifying number to the settlement apparatus; 2) transmitting a synchronization confirmation signal indicating the establishment of synchronization with the billing terminal; or 3) processing settlement of the transaction between the billing terminal and the paying terminal, both of which are synchronized with each other by the transaction identifying number, based on the purchase amount. The combination thus fails to present a *prima facie* case of obviousness.

Reconsideration and withdrawal of the rejection of claims 1-11, 15, 17, 18 and 20-35 are respectfully requested.

Claims 12-14 were rejected under 35 U.S.C. § 103(a) over Mobile Commerce (U-V) in view of PR Newswire (X) and PR Newswire (UU) and Steinberg (VV) and claims 16 and 19 were rejected over Mobile Commerce (U-V) in view of PR Newswire (X) and Meyers (WW). The rejections are respectfully traversed.

Claims 12-14, 16 and 19 recite additional features of the invention and are allowable for the same reasons discussed above with respect to claim 1 and for the additional features recited therein. In addition, it is respectfully submitted that PR Newswire (UU), Steinberg (VV) and Meyers (WW), alone or in combination, fail to cure the deficiencies of Mobile Commerce (U-V) in view of PR Newswire (X) discussed above with respect to claim 1.

Reconsideration and withdrawal of the rejections of claims 12-14, 16 and 19 are respectfully requested.

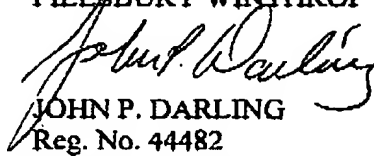
In view of the above amendments and remarks, Applicant respectfully submits that all the claims are allowable and that the entire application is in condition for allowance.

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Should the Examiner believe that anything further is desirable to place the application in better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

PILLSBURY WINTHROP SHAW PITTMAN LLP



JOHN P. DARLING

Reg. No. 44482

Tel. No. (703) 905-2045

Fax No. (703) 905-2500

Date: May 27, 2005
P.O. Box 10500
McLean, VA 22102
(703) 905-2000